

REMARKS

Claims 1-11 and 17-26 are pending.

Claims 1-11 and 17-26 stand rejected.

Claims 1, 4, 10, 11, 17, 20, 21, 23, and 25 have been amended.

Reconsideration and allowance of all pending claims is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM OBJECTION

Claim 11 stands objected to for including a double instance of the word “the.” An amendment has been made which is believed to render the rejection moot. Applicants, therefore, respectfully request withdrawal of the objection to Claim 11.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 1-11 and 17-26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0145091 to Peng et al. (“Peng”). Applicants respectfully traverse.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24

U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Applicants have amended independent Claims 1, 17, 20, and 23 in similar manner to clarify distinctions between the prior art and the rejected claims. For instance, Applicants have amended independent Claim 1 to recite, among other things,

in response to the identification of the call as a packet data call for specific packet-based applications, generating a request message for delivery from a routing agent within the base station subsystem to a call processor within the base station subsystem, the request message comprising a call setup request and a radio link setup request; and

in response to receiving the request message,

initiating setup of the call, the setup initiation comprising transmitting a message to a packet control function operable for allocating packet data resources to establish a packet data session for the call, and

contemporaneously with the call setup initiation, allocating radio link related resources to establish a radio link between the mobile station and the base station subsystem for the call. . . .

The Office Action states that Peng, in view of admitted prior art, discloses all of the recited elements and limitations. Applicants note that even if what is asserted as “admitted prior art” is, in fact, prior art, and even if Peng could be properly combined with the allegedly admitted prior art, Peng would still fail to disclose each and every element and limitation recited in Claim 1. For instance, Peng, together with allegedly admitted prior art (“the Cited Art”), fails to disclose or suggest, that generating a request message (which comprises a call setup request and a radio link setup request) is done “in response to the identification of the call as a packet data call for specific packet-based applications. . . .” Further, the Cited Art fails to disclose or suggest that such a request message is “for delivery from a routing agent within the base station to a call processor within the base station. . . .” Also, the Cited Art fails to disclose or suggest that the contemporaneous steps of initiating setup and allocating radio link resources is done “in response to receiving the request message. . . .”

Moreover, the Cited Art fails to disclose or suggest “generating a request message . . . comprising a call setup request and a radio link setup request” or “contemporaneously” initiating setup of the call and allocating radio link resources. It is admitted in the Office Action that Applicants’ allegedly admitted prior art does not disclose these limitations. Applicants respectfully submit that Peng does not cure the deficiency. To the contrary, to the extent it can be said that Peng shows a call setup request and a radio link allocation request, Peng discusses these two requests as being in *separate non-contemporaneous messages*. And, Peng discusses these two requests *as being performed separately and not contemporaneously*.

Peng discloses these two steps as being done separately and at different times. Fig. 2 of Peng, and the accompanying text, shows that the step of allocating resources (step 250) is only

performed after the call initiation request (step 200) has been processed. As stated in Peng [0025], “As shown in FIG. 2, to initiate a data session, an AT sends a Unicast Access Terminal Identifier (UATI) request to the AN (step 200) . . . Upon receipt of the UATI, the AT engages in a session protocol negotiation process with the serving AN (step 210).” As noted in Peng [0026], however, “After session configuration, the AT initiates Point-to-Point Protocol (PPP) and Link Control Protocol (LCP) negotiations for access authentication (step 220). Further, Peng [0027] states that “After authentication, the PCF initiates the setup of an A10 connection with the PDSN (step 230).” Finally, according to Peng [0027], and only after the call initiation request has been processed (e.g., session protocol negotiation, authentication negotiation, etc.), “The AT can send a connection request message to the AN, which in turn allocates radio resources . . . ”

The Office Action suggests that *Kerkhoven* stands for the proposition that it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. Applicants respectfully submit that *Kerkhoven* is irrelevant to the situation at hand for a number of reasons. First, and as noted in the Office Action, *Kerkhoven* dealt with compositions of matter, not information in a telecommunications message, or telecommunication processing steps, as in Applicants’ disclosure. Second, *Kerkhoven* was limited to situations where the two compositions being combined were compositions taught by the prior art to be useful for the same purpose and the combined (third) composition was likewise useful for the same purpose. Even accepting arguendo the inappropriate analogy of compositions of matter to telecommunications messages and steps, Applicants call setup request and radio link request are not “for the same purpose.” Similarly, Applicants combined “request message” is not “for the same purpose.” For at least these reasons, *Kerkhoven* is completely inapplicable and provides no support for the proposition that it is *prima facie* obvious to combine two different messages into one message in a telecommunications environment, or to contemporaneously execute two different processes.

Applicants respectfully note that independent Claims 17, 20, and 23 (amended) also recite similar elements and limitations. It is respectfully submitted that the above remarks apply equally to independent Claims 17, 20, and 23, as well as to all of the dependent claims.

Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 U.S.C. § 103.

III. CONCLUSION

As a result of the foregoing, Applicants respectfully assert that the pending claims are in condition for allowance, and respectfully request allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@munckcarter.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, LLP

Date: 11/9/2010



Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@munckcarter.com